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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,870	01/30/2004	Yoko Hirotsugi	00862.023427.	4094

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EXAMINER

UHLHAKKE, JASON S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/766,870	Applicant(s) HIROSUGI ET AL.	
	Examiner Jason Uhlenhake	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 15 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 15, 26-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Murashima (U.S. Pub. 2004/0061887).

Murashima discloses:

- ***regarding claims 1, 10, 15***, a storage unit for storing a set value/image data; transmitting/providing unit for transmitting the set value/image data, which has been stored in the storage unit, in response to a request from the host device; and an updating/receiving unit for receiving print data from the host device and then updating the set value, which has been stored in the storage unit, based upon print data received from the host device (Paragraph 0021)

Claims 2, 8, 9, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Otokita (U.S. Pub. 2003/0016259).

- ***regarding claim 2***, an image forming apparatus for receiving data from a host device (1) and forming an image (Figure 1), comprising:

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- a storage unit for storing a set value (Paragraph 0011)
- notifying unit for deciding a set value of the image forming apparatus in response to an image formation request from the host device, comparing the set value decided and the set value that has been stored in said storage unit, processing the image formation request if the two set values agree and, if the two set values do not agree, notifying the host device of this fact (Paragraphs 0076 – 0078)
- **regarding claim 8**, information processing apparatus, which is connected to said image forming apparatus, for receiving notification from said image forming apparatus and displaying it on a display (Paragraph 0048, Claim # 29)
- **regarding claim 9**, image forming system in which a latest set value that has been stored in a printer is acquired and, if the set value differs from a set value that has been specified, this fact is reported (Paragraphs 0076 – 0078)
- **regarding claim 11**, method of controlling an image forming apparatus that receives data from a host device and forms an image comprising: a storage unit for storing a set value (Paragraph 0011)
- notifying unit for deciding a set value of the image forming apparatus in response to an image formation request from the host device, comparing the set value decided and the set value that has been stored in said storage unit, processing the image formation request if the two set values agree and, if the two set values do not agree, notifying the host device of this fact (Paragraphs 0076 – 0078)

Claims 26, 30, 31, 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al (U.S. Pat. 6,775,025).

Robinson et al discloses:

- ***regarding claims 26 and 31***, an acquiring step of acquiring a previous setting previously utilized from the printer; a comparing step of comparing a current setting of print data to be transmitted and the previous set value acquired in the acquiring step (Abstract, Column 5, Lines 26 – 35)
- an alerting step of, when the previous setting is not identical with the current setting, alerting a user; and a transmitting step of, when the previous setting is identical with the current setting, transmitting print data to the printer (Abstract, Column 5, Lines 26 – 45; Column 6, Lines 53 – 60)
- ***regarding claims 30 and 35***, if previous setting is identical with the current setting, adding a confirmation print OFF command to the print data, else adding a confirmation print ON command to the print data; wherein when the printer receives the confirmation print ON command, the printer starts printing after a confirmation is input, when the printer receives the confirmation print OFF command, the printer starts printing without a confirmation (Column 5, Lines 26 – 62; Column 6, Lines 42 – 60)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murashima (U.S. Pub. 2004/0061887) in view of Otokita (U.S. Pub. 2003/0016259).

Murashima discloses:

- ***regarding claim 7***, a storage unit for storing a set value/image data; transmitting/providing unit for transmitting the set value/image data, which has been stored in the storage unit, in response to a request from the host device; and an updating/receiving unit for receiving print data from the host device and then updating the set value, which has been stored in the storage unit, based upon print data received from the host device (Paragraph 0021)

Murashima does not disclose expressly the following:

- ***regarding claim 3***, wherein the set value that has been stored in said storage unit includes size or type or both size and type of a sheet-like medium on which an image is formed
- ***regarding claim 4***, wherein set value that has been stored in said storage unit includes a setting of distance between an ink-jet printhead and a sheet
- ***regarding claim 7***, information processing apparatus comprises: an acquisition unit for acquiring a set value from said image forming apparatus
- comparison unit for comparing a specified set value (printhead gap value) in image formation and the set value (medium type) that has been acquired by said acquisition unit, transmitting an image formation request to the image forming unit if the

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two set values agree and, if the two set values do not agree, displaying this fact by a display

Otokita discloses:

- ***regarding claim 3***, wherein the set value that has been stored in said storage unit includes size or type or both size and type of a sheet-like medium on which an image is formed (Paragraph 0011), for the purpose of enabling appropriate printing according to a printing medium.

- ***regarding claim 4***, wherein set value that has been stored in said storage unit includes a setting of distance between an ink-jet printhead and a sheet (Paragraphs 0012, 0037), for the purpose of enabling appropriate printing according to a printing medium.

- ***regarding claim 7***, information processing apparatus comprises: an acquisition unit for acquiring a set value from said image forming apparatus (Paragraph 0011), for the purpose of enabling appropriate printing according to a printing medium.

- comparison unit for comparing a specified set value (printhead gap value) in image formation and the set value (medium type) that has been acquired by said acquisition unit, transmitting an image formation request to the image forming unit if the two set values agree and, if the two set values do not agree, displaying this fact by a display (Paragraph 0047), for the purpose of enabling appropriate printing according to a printing medium.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of wherein the set value that has

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been stored in said storage unit includes size or type or both size and type of a sheet-like medium on which an image is formed; wherein set value that has been stored in said storage unit includes a setting of distance between an ink-jet printhead and a sheet; information processing apparatus comprises: an acquisition unit for acquiring a set value from said image forming apparatus; comparison unit for comparing a specified set value (printhead gap value) in image formation and the set value (medium type) that has been acquired by said acquisition unit, transmitting an image formation request to the image forming unit if the two set values agree and, if the two set values do not agree, displaying this fact by a display as taught by Otokita into the device of Murashima. The motivation for doing so would have been to enable appropriate printing according to a printing medium.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murashima (U.S. Pub. 2004/0061887) in view of Otokita (U.S. Pub 2003/0016259) and Aritomi (U.S. Pub. 2002/0180822).

Murashima does not disclose expressly the following:

- ***regarding claim 5***, a panel for displaying messages and specifying inputs; a determination unit for determining whether data received from the host device includes a confirmation command; confirmation command is determined once test printing to the plain paper ends

- confirmation unit for displaying a message on said panel and prompting an input in response to this message if said determination unit has determined that the data includes a confirmation command

- wherein an image is formed based upon the data if an input in response to the message is made by confirmation unit

Aritomi discloses the following:

- ***regarding claim 5***, a panel for displaying messages and specifying inputs; a determination unit for determining whether data received from the host device includes a confirmation command; confirmation command is determined once test printing to the plain paper ends (Paragraph 0077). For the purpose of displaying to the user a confirmation command.

- confirmation unit for displaying a message on said panel and prompting an input in response to this message if said determination unit has determined that the data includes a confirmation command (Paragraph 0077). For the purpose of allowing the user to control operation of the image forming apparatus.

- wherein an image is formed based upon the data if an input in response to the message is made by confirmation unit (Paragraph 0077). For the purpose of performing print output to a print medium on the basis of print data being transmitted.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of a panel for displaying messages and specifying inputs; a determination unit for determining whether data received from the host device includes a confirmation command; confirmation command is determined

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once test printing to the plain paper ends; confirmation unit for displaying a message on said panel and prompting an input in response to this message if said determination unit has determined that the data includes a confirmation command; wherein an image is formed based upon the data if an input in response to the message is made by confirmation unit as taught by Otokita and Aritomi into the device of Murashima. The motivations would have been to display to the user a confirmation command; allow the user to control operation of the image forming apparatus; perform print output to a print medium on the basis of print data being transmitted.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murashima (U.S. Pub. 2004/0061887) in view of Aritomi (U.S. Pub. 2002/0180822).

Murashima does not disclose expressly the following:

- ***regarding claim 12***, a determination unit for determining whether data received from the host device includes a confirmation command; confirmation command is determined once test printing to the plain paper ends
- confirmation unit for displaying a message on said panel and prompting an input in response to this message if said determination unit has determined that the data includes a confirmation command
- wherein an image is formed based upon the data if an input in response to the message is made by confirmation unit

Aritomi discloses the following:

- ***regarding claim 12***, a determination unit for determining whether data received from the host device includes a confirmation command; confirmation command is determined once test printing to the plain paper ends (Paragraph 0077). For the purpose of displaying to the user a confirmation command.

- confirmation unit for displaying a message on said panel and prompting an input in response to this message if said determination unit has determined that the data includes a confirmation command (Paragraph 0077). For the purpose of allowing the user to control operation of the image forming apparatus.

- wherein an image is formed based upon the data if an input in response to the message is made by confirmation unit (Paragraph 0077). For the purpose of performing print output to a print medium on the basis of print data being transmitted.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of a panel for displaying messages and specifying inputs; a determination unit for determining whether data received from the host device includes a confirmation command; confirmation command is determined once test printing to the plain paper ends; confirmation unit for displaying a message on said panel and prompting an input in response to this message if said determination unit has determined that the data includes a confirmation command; wherein an image is formed based upon the data if an input in response to the message is made by confirmation unit as taught by Aritomi into the device of Murashima. The motivations would have been to display to the user a confirmation command; allow the user to

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control operation of the image forming apparatus; perform print output to a print medium on the basis of print data being transmitted.

Claims 27, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al (U.S. Pat. 6,775,025) in view of Carter et al (U.S. Pub 2003/0202199)

Robinson et al discloses all the claimed limitations above except for the following:

- ***regarding claims 27 and 32***, determining whether the previous user and the current user of the printer are the same, if it is determined that the previous user and the current user of the printer are no the same, the previous setting is acquired from the printer in the acquiring step else the print data is transmitted to the printer in the transmitting step

Carter et al discloses:

- ***regarding claims 27 and 32***, determining whether the previous user and the current user of the printer are the same, if it is determined that the previous user and the current user of the printer are no the same, the previous setting is acquired from the printer in the acquiring step else the print data is transmitted to the printer in the transmitting step (Abstract; Paragraph 0005; Claim 20), for the purpose of identifying authorized users of the image forming apparatus.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of determining whether the previous user and the current user of the printer are the same, if it is determined that the previous

user and the current user of the printer are no the same, the previous setting is acquired from the printer in the acquiring step else the print data is transmitted to the printer in the transmitting step as taught by Carter et al into the device of Robinson et al. The motivation for doing so would have been to identify authorized users of the image forming apparatus.

Claims 28, 29, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al (U.S. Pat. 6,775,025) in view of Otokita (U.S. Pub. 2003/0016259)

Robinson et al discloses all the claimed limitations above except for the following:

- ***regarding claims 28 and 33***, the setting includes information representing the position of the paper-clearance adjusting lever
- ***regarding claims 29 and 34***, the settings include a media type

Otokita discloses:

- ***regarding claims 28 and 33***, the setting includes information representing the position of the paper-clearance adjusting lever (Paragraphs 0011 – 0012; 0047), for the purpose of enabling appropriate printing according to a printing medium.
- ***regarding claims 29 and 34***, the settings include a media type (Paragraphs 0011 – 0012; 0047), for the purpose of enabling appropriate printing according to a printing medium.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of the setting includes information representing the position of the paper-clearance adjusting lever; the settings include a media type as taught by Otokita into the device of Robinson et al. The motivation for doing so would have been to enable appropriate printing according to a printing medium.

Response to Arguments

Applicant's arguments with respect to claims 1 – 5, 7 – 12, 15, 26 - 35 have been considered but are moot in view of the new ground(s) of rejection. Please see the above rejections regarding Murashima (U.S. Pub. 2004/0061887), Robinson et al (U.S. Pat. 6,775,025), Murashima in view of Otokita (U.S. Pub. 2003/0016259), and Robinson et al in view of Otokita. They disclose an updating unit for receiving print data from the host device and then updating the set value that has been stored and compare a current setting of print data and a previous setting, and depending on the result, alerting the user or transmitting the print data.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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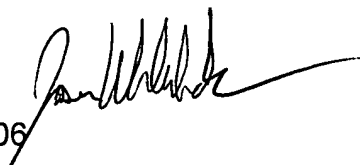
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Uhlenhake whose telephone number is (571) 272-5916. The examiner can normally be reached on Monday - Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSU

May 24, 2006



 5/24
K. FEGGINS
PRIMARY EXAMINER